UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,381	09/20/2005	Eisuke Sasaoka	50212-631	6952

20277 7590 06/13/2007
MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
LEPISTO, RYAN A	

ART UNIT	PAPER NUMBER
2883	

MAIL DATE	DELIVERY MODE
06/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/519,381	SASAOKA ET AL.	
	Examiner	Art Unit	
	Ryan Lepisto	2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,18 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,18 and 19* is/are rejected.

7)☒ Claim(s) *18* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 18 is objected to because of the following informalities: The claim depends from cancelled claim 17. It will be assumed this claim should depend from claim 1 for this action. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bickham et al (US 2003/0174988 A1)** (Bickham) in view of **Kato et al (US 6,266,467 B1)** (Kato).

Bickham teaches a silica glass optical fiber having a core (not containing germania, paragraph 0095)) and cladding have the following properties: a transmission loss at 1380 nm is preferably less than about 0.4 dB/km (paragraph 0017), a transmission loss at 1310 nm being the same as the attenuation at 1380 nm or within 0.05 dB/km the transmission loss at 1380 nm or the transmission loss at 1380 is lower than the transmission loss at 1310 nm (paragraph 0017), a mode field diameter at 1310 nm of 6.5 to 6.7 μm (Table 2), a chromatic dispersion at 1550 nm between 5 and 9 ps/nm/km (paragraph 0010), a dispersion slope at 1550 nm is less then about 0.042

$ps/nm^2/km$ (paragraph 0013), a cable cutoff of less than 1240 nm (paragraph 0014), a transmission loss at 1550 nm of less than about 0.02 dB/km (paragraph 0016), the difference between transmission loss at 1550 nm and at 1310 nm being between 0.1 to 0.4 (from the values in paragraph 0017), polarization mode dispersion at 1550 nm of less than about 0.04 $ps/km^{1/2}$ (paragraph 0018), a core outer diameter of between 6 and 10 μm (paragraph 0024), a refractive index difference between the core and cladding of between 0.1% to 0.6% (from the values in paragraphs 0023 and 0030, which is the difference between the core and the outer cladding), loss due to OH induced water peaks at 1380 nm being virtually eliminated (paragraph 0112), a measured zero dispersion wavelength of between 1308 and 1316 nm (Table 2) and a dispersion slope at 1400 nm (which is in the preferable zero dispersion wavelength range (0010)) of 0.037 to 0.039 $ps/nm^2/km$ (Table 2).

Bickham does not teach expressly an exact range of transmission loss of less than 0.32 dB/km at 1310 nm.

Bickham teaches attenuation in a range around 0.4 dB/km as previously discussed.

At the time the invention was made, it would obvious to a person of ordinary skill in the art to achieve low transmission ranges. Applicant has not disclosed that an exact range less than 0.32 dB/km provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the fiber taught by Bickham because of the low transmission taught that overlaps applicant's claimed range.

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Further, it has been held that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). For more recent cases applying this principle, see Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

The motivation for doing so would have been reduce the need for amplifiers and/or repeaters along the transmission line by being able to reduce losses in the line.

Bickham also does not teach expressly the cladding doped with fluorine.

Kato teaches a fiber having a fluorine-doped cladding (column 27 lines 4-17).

Bickham and Kato are analogous art because they are from the same field of endeavor, optical fibers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to dope the cladding with fluorine since Bickham teaches it is known to

diffuse dopants during manufacturing to round the corners of index profiles of his invention (paragraph 0127).

The motivation for doing so would have been to be able to enhance refractive index differences between layers will still allowing relatively easy manufacturing methods (Kato, column 27 lines 15-17).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham in view of Kato as applied to claims 1-6 and 18-19 above, and further in view of **Sasaoka et al (US 6,345,140 B1)** (Sasaoka).

Bickham teaches the fiber previously discussed.

Bickham does not teach expressly the value of the Petermann-I mode field diameter.

Sasaoka teaches that the Petermann-I mode field diameter is related to the mode field diameter by the known equations 1a and 1b (column 1 lines 52-59).

Bickham and Sasaoka are analogous art because they are from the same field of endeavor, optical fibers.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art that the fiber taught by Bickham will have a Petermann-I mode field diameter less than 10μm using the equations provided by Sasaoka since Bickham teaches a mode field diameter at 1550 nm of 7.5 to 7.7 μm (Table 2).

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed.

Cir. 1990). Further, it has been held that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). For more recent cases applying this principle, see Merck & Co. Inc. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In re Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).

The motivation for doing so would have been to have a better way to described the mode field diameter of the fiber while including the relationship of the electric field amplitude and a positional variable (Sasaoka, column 1 lines 52-65).

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: This claim would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims because the latter, either alone or in combination, does not disclose nor render

obvious an optical fiber mainly comprising silica glass having the combination of numerical property limitations giving the claim, in combination with the rest of the claimed limitations.

Response to Arguments

Applicant's arguments filed 5/25/07 have been fully considered but they are not persuasive.

In response to the argument that Bickham teaches away from a cladding region doped with fluorine: Applicant points to paragraph 0095 of Bickham for the evidence of the teaching away of a doped fluorine cladding. While it does state that preferably the cladding contains no fluorine, the same paragraph states that the cladding may indeed include one or more dopants (paragraph 0095).

The motivation for doing so would have been to be able to enhance refractive index differences between layers will still allowing relatively easy manufacturing methods (Kato, column 27 lines 15-17).

It is important to note that merely teaching something different from the claimed invention is not a "teaching away" from the claimed invention. For a reference to teach away from a claimed invention there has to be an explicit teaching that the claimed invention is undesirable. For example, a reference teaching that a feature would render an invention unusable is "teaching away" since it explicitly says the feature is undesirable. In contrast, a reference teaching a different feature does not teach away from the claimed invention, it just does not anticipate the claimed invention. See MPEP section 2141.01 and 2145 for further discussion on the "teaching away" of references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Lepisto whose telephone number is (571) 272-1946. The examiner can normally be reached on M-Th 7:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RAL/
Ryan Lepisto
Art Unit 2883

Frank Font
Supervisory Patent Examiner
Technology Center 2800